Who Owns the Intellectual Property Rights in Academic Work?†

JUSTINE PILA*

On 13 May 2010, the Times Higher Education reported a dispute between Newcastle University and a retired Professor of Pharmacology whom Newcastle had continued to engage on a teaching contract.¹ The dispute concerned the ownership of copyright in the Professor’s teaching materials, and draws attention to the legal and policy questions, who owns the intellectual property rights in academic work?, and what rights ought universities to claim in respect of that work?

In the United Kingdom and elsewhere, universities’ concern with the commercial exploitation of academic ideas is a relatively recent phenomenon. Delivering the Herchel Smith Lecture on the topic in 1991,² W. R. Cornish contextualized it in these terms:

Government has traditionally not only equipped and maintained universities in general, but it has also made major grants for campus research on specific projects. In the quarter-century after 1945, much as in the United States and elsewhere, the research agenda tended to be set from

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* University Lecturer in Intellectual Property Law, University of Oxford; Official Fellow and Senior Law Tutor, St Catherine’s College, Oxford. Email: justine.pila@law.ox.ac.uk.


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within the academic community, with much reliance being placed on the judgment of peers. Resources were concentrated on work at the pure, fundamental end of the spectrum, a certain disdain being shown towards mere practical applications. In line with this attitude, universities showed no undue concern for the commercial potential of academic ideas. If the research was the product of industrial sponsorship, it was common to leave the rights of exploitation to the sponsor. If government paid for the work through a Research Council or similar grant, it required that practical exploitation should be given, on a first refusal basis, to the National Research Development Corporation – subsequently revitalized as the British Technology Group.3

During the 1980s, public funding for universities declined, alongside a change in attitude to universities and in the nature of scientific research. The result was reflected in the Cabinet Office’s 1983 Nicholson Report,4 and its follow-up 1992 publication, Intellectual Property in the Public Sector Research Base,5 which emphasized the role of universities in ensuring “that the commercial potential of new ideas emerging from research is fully appreciated and exploited”.6 As Professor Cornish observed, the “determination to make the most of research” was “one important strand in a process of re-defining the very concept of a university”7 from “Academe” to “competitive and calculating Technopolis”.8

Since this observation nearly 20 years ago, both the determination to turn academic research to account and its accompanying process of re-definition have continued apace. Nonetheless, and as the Newcastle University case reflects, the question of intellectual property ownership remains very much alive, and in need of attention. Further, it is the law of ownership which requires attention, as much as the concept of intellectual property per se. The distinction is important, as a consideration of the University of

3 Ibid 13.
6 Ibid 7.
7 Cornish (n 2) 13.
8 Cornish (n 2) 13, 14.
Manchester’s *Who Owns Science? The Manchester Manifesto* demonstrates. The Manifesto was authored over 19 months by an interdisciplinary team of researchers led by two University of Manchester research institutes – the Institute for Science, Ethics and Innovation, and the Brooks World Poverty Institute – chaired by Nobel prize winners John Sulston and Joseph Stiglitz respectively. Their explicit purpose was “to investigate the question of ‘Who Owns Science?’ [and] to present and apply [their] findings to maximum effect”. However, the “ownership” with which the Manifesto is concerned is only “the idea of ‘ownership’”. Thus, while the Manifesto may help to identify general issues of policy regarding the exploitation of intellectual property rights, it does not help to identify who has those rights of exploitation – ie, in whom intellectual property rights actually vest – which is an essential preliminary question.

The main forms of intellectual property in academic work are copyright and patents. Under United Kingdom legislation, copyright in an original literary, musical or other work is owned by its author(s), and the right to patent an invention is reserved primarily to its inventor(s). However, an exception exists for works and inventions made in the course of employment. In that case, the copyright or invention is generally owned by the employer, who also has the right to patent the invention. Whether an employer can claim ownership of the copyright subsisting in works created by its employees outside the course of employment is unclear. According to section 11(2), “[w]here a literary, dramatic, musical or artistic work, or a film, is made by an employee in the course of his employment, his employer is the first owner of any copyright in the work subject to

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10 Ibid 0.
11 Ibid, emphasis added.
12 Copyright, Designs and Patents Act 1988 (C.D.P.A.) s. 11(1); Patents Act 1977 (P.A.) s. 7(1).
13 C.D.P.A. s. 11(2); P.A. ss. 7(2)(b), 39–43.
any agreement to the contrary.” On one reading, this section assumes (or is at least consistent with) freedom of contract regarding the ownership of copyright in employee works. On another reading, it recognizes only the right contractually to displace a statutory presumption of employer ownership. By contrast, legislation expressly prohibits the equivalent in respect of inventions, by prohibiting the contractual diminution of employee inventors’ statutory rights.14

It is widely assumed that the legislative scheme governing employer ownership of copyright and inventions applies indiscriminately, including in the context of academic employers. The result is that universities are assumed to own the copyright in the lectures, books, musical scores, research notes and other works created by academic employees in the course of their employment, along with any innovative methods or products which they devise. This assumption is reflected in the intellectual property policies of most United Kingdom universities, and in the tech transfer initiatives which those policies support.

However, it is unclear that the assumption is correct. Elsewhere I have argued that it is not, relying on statements such as this by Lord Evershed:15

[Prima facie] I should have thought that a man, engaged on terms which include that he is called upon to compose and deliver public lectures or lectures to some specified class of persons, would in the absence of clear terms in the contract of employment to the contrary be entitled to the copyright in those lectures. That seems to me to be both just and commonsense. The obvious case to which much reference by way of illustration was made in the course of the argument is the case for the academic professions. Lectures delivered, for example, by Professor Maitland to students have since become classical in the law. It is inconceivable that because Professor Maitland was in the service at the time of the University of

14 P.A. s. 42(2).
Cambridge that anybody but himself … could have claimed the copyright in those lectures.\textsuperscript{16}

Lord Evershed’s suggestion that it is “just and commonsense” that academics own the copyright in their lectures, and by extension the copyright in their research, might explain why many universities shy away from claiming all academic copyright, and why some expressly undertake not to assert ownership of copyright in a range of academic works.\textsuperscript{17} Importantly, the latter do not say that they do not have the right to claim copyright, only that they will not exercise that right for the specified works. However, in a context in which British universities are increasingly expected to be financially self-sufficient, and are turning increasingly to the commercial returns from teaching and academic research to fulfil this expectation, one can readily imagine a change of position, and the argument that would accompany it. Universities, it might be said, with their tech transfer officers, are better positioned than academics to exploit the copyright in their works, will share the revenue they earn from such exploitation with individual academics, and with the assistance of that revenue, will be better able to support the humanities and other under-resourced departments.

However, it is far from clear that such an argument justifies a claim to the copyright in academic works, whatever the formal legal position. One reason is the impact on universities of giving them economic rights in respect of those works. In times of financial pressure, a university’s possession of such rights can be expected to distort its recruitment and other academic policies by orienting them towards those outcomes most likely to maximize economic returns. Further, legislation already permits certain uses of works for instructional, examination, study and research purposes,\textsuperscript{18} and the

\textsuperscript{17} On the legal effect of such undertakings see below (n 32).
\textsuperscript{18} See C.D.P.A. ss. 29 (research and private study), 32 (instruction or examination). For the equivalent patent law provisions see P.A. s. 60(5) (deeming acts done privately and for non-commercial purposes, or for
common law likely gives universities a right to re-use their employees’ teaching materials. This means that universities ought not in any case to need copyright to fulfil their public benefit educational objectives. (And if the law is insufficient in this regard, the appropriate response is to seek its amendment.) Finally, there is the impact of university ownership of copyright on academic authors themselves. This is demonstrated by the Newcastle case, where the result of the University’s claim, if accepted, will be to prevent the Professor: (a) from using the materials which he created without the University’s permission; and (b) from invoking the moral rights afforded to other authors, including by insisting that he, and not the lecturer by whom he was replaced, be identified as the materials’ author. Such a result is unjust and defies common sense, particularly given that the materials were the product “considerable effort” and intellectual investment by the Professor, having been authored as part of his revision of the course curriculum. It also raises issues of institutional integrity, for it is difficult to see how a university can expect its students and other members to observe anti-plagiarism codes if it fails to insist on the proper attribution of its teaching materials.

If it is accepted that justice and common sense support academics owning the copyright in their lectures and research, the question arises why they do not equally support academics owning the inventions they devise, particularly when the legal rationale for employer ownership is the same for inventions as for copyright; namely, that employers ought to receive the benefits for which they pay and support their employees.

One basis for distinguishing copyright from inventions might be the argument that inventors do not have the same intellectual or moral claim to their inventions as authors have to their works and associated copyright. To some extent, this argument derives support

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19 See Stephenson Jordan (1952) 69 RPC 10, 22 (Denning LJ), 23 (Morris LJ).
20 See C.D.P.A. pt 1, ch. IV.
21 See C.D.P.A. s. 79(3).
22 Newman (n 1) 12.
from the different attribution norms that apply in the applied sciences, which suggest that authors have a different relationship to their creations than inventors have to their innovations. Specifically, and unlike in the humanities and most social/pure sciences, being identified as an author of an academic paper reporting the results of experimental scientific work does not necessarily indicate direct involvement in the work or responsibility for the results. Given this, we might infer that academic responsibility for applied science – including inventions and innovations – means something different from academic responsibility for history, philosophy, and pure mathematics, etc., and that this in turn reflects the different claims of inventors and authors to their research. However, the science-model of attribution is contentious, as is the view that copyright has a moral or other natural law basis, making this argument unlikely to be accepted.

Another argument that might be made is that academics in certain fields at least are employed to invent, with the result that their employing university ought to own any inventions which they devise. However, and as one senior British Judge has remarked, whether someone can be “employed to invent” is questionable, whatever the terms of his or her employment contract. The reason is that invention is by its nature not something that can reasonably be required (or expected) of a person, in contrast to a duty to research with a view to trying to innovate. However, in the university context, even a requirement to try to innovate – in contrast to a duty simply to research – is problematic, for it sits uneasily with principles of academic freedom, including the freedom to pursue and determine one’s line of thought. Further, if it is accepted that academics are employed to invent, they might equally be regarded as employed to write books and to script all of the lectures they give. In this way, the

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“duty to invent” argument leads to a rejection of Lord Evershed’s view of what is “just and commonsense” for copyright.24

A third argument might focus not on the employment duties of academics, but how academics are paid and supported by their employing university. For example, in the applied sciences it might be said that universities provide the labs and other physical infrastructure without which academics could not research, and that it is in recognition of this that they own any inventions resulting from their research. On the other hand, this does not explain universities’ ownership of inventions devised by academics working outside of their labs. Also, in a context in which researchers are increasingly expected to solicit their own external funding for labs and other resources – and expected (under pressure of teaching and administration) to undertake their research after hours – this argument breaks down, as one appellate Court has recognized.25 Finally, its logic equally supports universities owning academic copyright, for even academics in the humanities and social/pure sciences depend on library materials, physical space, and other university resources to undertake their work.

In conclusion, it is difficult to see why academic inventions ought to be treated differently from academic copyright, and why the legal rationale for employer ownership applies at all in respect of academic teaching and research. And indeed, this has been the implication of the courts in the few cases in which the intellectual property rights of academic employees have been considered.

For example, in a 1996 case involving a disputed claim by a teaching hospital to an invention devised by a junior registrar, Jacob J. of the High Court relied on Lord Evershed’s statement above to determine the case for the registrar. In his opinion:

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24 See Stephenson Jordan (1952) 69 R.P.C. 10, 22 (Denning L.J., suggesting that “a doctor on the staff of a hospital, or a master on the staff of a school” who is employed “to give lectures or lessons orally to students” and who reduces the lecture or lesson to writing, does so “for his own convenience,” and not as part of his contracted work).

Doctors frequently devise new and better treatments. Some of those will involve patentable inventions. Most doctors are employed. If, just because they are employed and because the invention could be used for the purpose of their employment, the invention belongs to the employer then many doctors would be placed in a very difficult position – ‘Can they publish what they have devised?’ ‘Do they have to get their employer’s permission to publish?’ At present they do not. I do not see why they should in the future.26

More recently, in 2009, the Full Court of the Federal Court of Australia relied on both Jacob J. and Lord Evershed’s decisions to reject a claim by the University of Western Australia to inventions and patents originating with its former Professor of Surgery.27 According to the Court, U.K.-derived common law principles governing employer ownership of employee inventions do not apply to Australian universities, due to the reality and conventions of academic employment. Important were some of the factors above, including: (a) the inability to assume that academics research exclusively in their university’s time and with university-provided resources; and (b) the independence and freedom of academics to determine the content and direction of their lectures and research. Ultimately, the case is most important for its view of universities as academic communities rather than commercial enterprises:

UWA has not been immune from the forces, financial and otherwise, that are forcing changes in the character of the university sector in Australia. ... UWA has engaged in commercial activities, as have done ‘most, if not all, universities’. The evidence put on by UWA as to the range, character and significance of such activities of UWA was slight, though it hoped … that we would take judicial notice of these matters… What is notable … is that there is nothing … to suggest that those commercial activities have displaced, either totally or if in part to what extent, UWA’s traditional public function as an institution of higher education in favour of the pursuit of commercial purposes (if it lawfully could do so under its Act). Its function, in other

words, was not limited to that of engaging academic staff for its own commercial purposes. Accordingly, we agree ... that on the evidence Dr Gray was not required to advance a commercial purpose of UWA when selecting the research he would undertake.28

According to the Court, “to define the relationship of an academic staff member with a university simply in terms of a contract of employment” – as application of the employer ownership provisions of intellectual property legislation would seem to entail – “is to ignore a distinctive dimension of that relationship,” namely, the “apparent manifestations of the contested value of ‘academic freedom’”.29 The result is judicial support for the following legal argument.30

Academics are not merely employees, but also members of a community of teachers and scholars. That community is constituted in part by its ethical commitment to the pursuit of truth, without regard to the implications of that pursuit for the commercial interests of its members’ employer. To treat universities in the manner of regular employers, so as to support their ownership of employee inventions and copyright, would undermine principles of academic freedom, and the ethic which constitutes universities as such.

The question who owns the intellectual property rights in academic work? is difficult, and raises many issues beyond the scope of this discussion. For example, it is affected by the labyrinthine contractual arrangements with external funding and research institutions that are increasingly central to scientists’ (and others’) research.31 Add to this

29 Ibid.
30 See Pila (n 15).
31 The point was emphasized by the primary judge (now Chief Justice of Australia) in UIWA v. Gray [2008] FCA 498, [14] as follows: “It would seem that the only secure way for UWA to acquire property rights from its academic staff in respect of intellectual property developed by them in the course of research at UWA is by express provision in their contracts of employment. Even then, as this case demonstrates, the transaction costs of administering and enforcing such provisions and the uncertainty surrounding their scope and application, raises a real question as to their
the uncertainty of the legal position, and the difficulty of determining
the validity of university policies (due to their differing source,
status, and grounds for review), and the issues become further
complicated. Nonetheless, they are sufficiently important that we
ought to engage with them. Further, the question we ought to
consider is not merely what rights can a university legally claim?, but
also what rights ought a university to claim?.

My own view is that whatever the legal position, a university
ought never to claim ownership of the copyright in its employee
academics’ lectures and research, nor of their inventions. I am not
suggesting that it ought not to seek to benefit directly or indirectly
from the exploitation of academic work. Rather, I am suggesting
that the starting point for discussing the ways in which it might so benefit
ought to be a position of employee rather than university ownership,
assuming this position could in law be assumed.32

I have deliberately refrained from discussing – much less
expressing an opinion on – the validity of individual universities’
intellectual property policies. I have also focused on regular academic
employees, as distinct from students and contract-based teachers and

utility. The length and complexity of this litigation has been exceptional.
However any claim by a university to intellectual property rights whose
creation has involved a team of research workers, external funding,
collaborative arrangements and extended periods of conceptual and
practical development is likely to pose similar difficulties. UWA and other
universities might well consider the alternative of deriving benefits from
inventions produced by their staff by offering highly competent and
experienced commercialisation services in exchange for a negotiated interest
in the relevant intellectual property. That alternative offers many benefits in
terms of incentives, harmony and certainty that are not available through
the enforcement of legal rights unlikely to be capable of precise definition.”
If legal ownership does vest in a university under statute, it is not clear that
this position could be assumed; ie, it is not clear that a disclaimer of
ownership by a university as employer would leave the relevant property
with the employee academic. For this reason, the effect of a university’s
undertaking not to enforce copyright in its academic employees’ works on
the employees’ rights with respect to such works is unclear.
researchers. However, it would be remiss not to note the following points. First, many policies are drafted sufficiently widely to cover the intellectual property originating with most if not all university members, including students and others engaged in study or research, regardless of whether they are also employees (or independent contractors). In such cases, membership alone is sufficient to trigger the university’s claim to intellectual property ownership. Among other things, this enables that claim to be cast expansively, and to ignore the different legal and policy issues which different categories of university members raise. And second, while the grounds for review of university legislation are somewhat obscure, they include compliance with primary legislation, reasonableness, and compatibility with the Human Rights Act 1998.\textsuperscript{33} The last may be of particular importance, due to the Act’s recognition of the right of persons to the peaceful enjoyment of their “possessions”, which right has been expansively interpreted in the intellectual property context.\textsuperscript{34}

At the end of the day, my suggestion is that whatever the validity of individual university IP policies, and the applicability of the employer ownership provisions of intellectual property legislation, greater thought ought to be given to the policy question, \textit{what intellectual property rights ought universities to claim in respect of academic work?}. My reason for suggesting this is not merely a concern for the rights of individual academics, but also for the impact of institutional intellectual property claims on the nature and values of universities themselves. Universities ought not to be dependent on the courts to explain to them how they differ from a commercial enterprise.
